

**Notice of Allowability**

Application No.

09/484,964

Examiner

Anne Marie S. Wehbe

Applicant(s)

YEH, EDWARD T. H.

Art Unit

1633

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendments filed on 7/3/06 and 7/5/06.
2. ☒ The allowed claim(s) is/are 73,90-92,100 and 101.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                       |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance              |
|   | 9. <input type="checkbox"/> Other _____.  |

### **EXAMINER'S AMENDMENT**

Applicant's amendment filed on 7/3/06 and the supplemental amendment filed on 7/5/06 have been entered. Claims 1-72, 74-87, 89, 93-97, and 99 are canceled. Claims 73, 88, 90-92, 98, and 100-101 are pending.

Applicant's amendment to the specification perfects their claim for benefit of priority to parent application 08/964,162, and further places the application in compliance with the requirements of 37 CFR 1.821-1.825 for amino acid and/or nucleotide sequences.

The examiner of record contacted the applicant's representative, Gina Shishima, to discuss claims 88 and 98. The examiner pointed out the previous office action had objected to claims 88 and 98 because they depend on canceled claims, and further rejected claims 88 and 98 under 35 U.S.C. 112, second paragraph, for indefiniteness, but the applicant's response did not address these issues and was therefore non-responsive. The examiner also indicated that cancellation of claims 88 and 98 would place the application in condition for allowance. The applicant's representative agreed to the cancellation of claims 88 and 98 by examiner's amendment.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Gina Shishima on 8/17/06.

The application has been amended as follows:

1. Claims 88 and 98 are canceled.

Claims 73, 90-92, and 100-101 are free of the prior art of record and allowable.

The following is an examiner's statement of reasons for allowance: the claimed methods are limited to a nucleic acid segment encoding a polypeptide comprising SEQ ID NO:2 or a nucleic acid segment comprising at least SEQ ID NO:1. While the closest prior art of record, such as Boddy et al. (see IDS of 5/1/00, references C1), teaches a nucleic acid sequence encoding a polypeptide referred to as PIC1 with ubiquitin-like activity, the polypeptide sequence of PIC1 differs from SEQ ID NO:2 at one amino acid residue. Also, the nucleotide sequence of PIC1 disclosed by Boddy et al. differs from SEQ ID NO:1 at 5 nucleotide residues. Thus, none of the prior art of record, including Boddy et al., teaches SEQ ID NO:1 or SEQ ID NO:2. Further, none of the prior art of record, including Boddy et al., teaches that a sequence similar to SEQ ID NO:1 or SEQ ID NO:2 has apoptosis inhibiting activity or could be used to inhibit Fas and/or TNFR1 mediated apoptosis in cells.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

Art Unit: 1633

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Dave Nguyen, can be reached at (571) 272-0731. For all official communications, **the new technology center fax number is (571) 273-8300**. Please note that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197.

Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'AMW', located below the printed name and title.